

PATENT  
ATTORNEY DOCKET NO. 057309-5002-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David M. Long *et al.* )  
Application No.: 10/018,691 )  
International filing date: July 2, 1999 ) Examiner: Unassigned  
For: TAXOL PRODUCTION VIA GENERATION OF ) Group Art Unit: Unassigned  
EXTRACHROMOSOMAL DNAs IN THE FUNGUS  
*PESTALOTIOPSIS* )

**Attention: International Division, Legal Staff**  
Box PCT  
Commissioner of Patents  
Washington, D.C. 20231

Sir:

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT  
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

The above-identified application became abandoned as to the United States because the elements noted at 35 U.S.C. 153(f) were not filed prior to the expiration of the applicable time limit noted at 37 CFR 1.136(a). The date of abandonment is two months and a day after the date of Notice of Missing Requirements, July 21, 2002.

Applicants hereby petition for revival of this application and include the following items:

1. Petition fee under 37 C.F.R. § 1.17(m)

The Commissioner is hereby authorized to charge \$650.00 to Deposit Account 50-0310.

2. Proper Response

A. The proper response (the missing 35 U.S.C. 371(c) requirements in the form of a Transmittal Letter, national stage application and basic national filing fee under 37 CFR § 1.492(a)(3)) is enclosed herewith.

04/23/2003 GFREY1 00000100 500310 10018691

02 FC:2453 650.00 CH

I-WA/1935583.1

PATENT

Attorney Docket No. 057309-5002-US

Application No. 10/018,691

Page 2

3. Terminal disclaimer with disclaimer fee

[X] Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

[ ] A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity of \$ \_\_\_\_\_ for other than a small entity) equivalent to the number of months from abandonment to the filing of this petition is enclosed herewith.

4. Statement. The entire delay in filing 35 U.S.C. 371(c) requirements from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By:



Erich E. Veitenheimer

Reg. No. 40,420

Date: April 18, 2003

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Ave, N.W.

Washington, D.C. 20004

Tel: (202) 739-3000

Fax: 202) 739-3001



Commissioner for Patents  
Washington, DC 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/018,691		David M Long	047714-5002-US

09629  
MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

**CONFIRMATION NO. 5141**  
**ABANDONMENT/TERMINATION**

**LETTER**



\*OC000000009349213\*

Date Mailed: 01/09/2003

**NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g)**

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 03/20/2002.

- No reply was received.

A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Any questions concerning petitions to revive should be directed to "Office of Petitions" at (703) 305-9282.

*A copy of this notice **MUST** be returned with the reply.*

Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

PATENT  
Attorney Docket No. 057309-5002-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David M. Long *et al.* )  
Application No.: 10/018,691 ) Group Art Unit: Unassigned  
International filing date: July 2, 1999 ) Examiner: Unassigned  
For: TAXOL PRODUCTION VIA GENERATION OF )  
EXTRACHROMOSOMAL DNA's IN THE )  
FUNGUS *PESTALOTIOPSIS* )

Box PCT  
Commissioner for Patents  
Washington, D.C. 20231

**PETITION FOR FILING AN APPLICATION UNDER 37 C.F.R. §1.47(a)**  
**with accompanying STATEMENT OF FACTS IN SUPPORT THEREOF**

Sir:

Joint inventors Eric D. Smidansky and Gary A. Strobel respectfully petition to file this application under 37 C.F.R. §1.47(a) for themselves and on behalf of non-signing inventor David M. Long.

Submitted with the Response to the Notice of Missing Requirements filed concurrently, is a Combined Declaration and Power of Attorney (copy attached hereto) signed by both Eric D. Smidansky and Gary A. Strobel. The circumstances relating to the inability of the real party in interest—Montana State University—to obtain the signature of the remaining inventor on the Declaration for the above-referenced application were set forth in an accompanying Statement of Facts attested to by Rebecca W. Mahurin, Ph.D., Director of Intellectual Property Administration and Technology Transfer, Montana State University, who has direct knowledge of the facts involved.

The non-signing inventor's last know address is:

414 S. 8th Street, Livingston, MT 59047

Attorney Docket No. 057309-5002  
Application No. 10/018,691  
Page 2

The Commissioner is hereby authorized to charge \$65.00 for the petition fee under 37 C.F.R. §1.17(i) to Deposit Account No. 50-0310.

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §1.16 and §1.17 which may be required, or credit any overpayment to Deposit Account No. 50-0310.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Date: April 18, 2003

  
Erich E. Veitenheimer  
Reg. No. 40,420

CUSTOMER NO. 09629  
MORGAN, LEWIS & BOCKIUS LLP  
1111 Pennsylvania Avenue, NW  
Washington, D.C. 20004  
(202) 739-3000

PATENT  
Attorney Docket No.: 057309-5002-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: David M. LONG *et al* )  
U.S. Application No.: 10/018,691 ) Group Art Unit: not assigned  
International filing date: July 2, 1999 ) Examiner: not assigned  
For: TAXOL PRODUCTION VIA GENERATION OF )  
EXTRACHROMOSOMAL DNAs IN THE )  
FUNGUS *PESTALOTIOPSIS* )

**Attention: International Division, Legal Staff**  
Box PCT  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

**STATEMENT OF FACTS IN SUPPORT  
OF PETITION UNDER 37 C.F.R. § 1.47(a)**

I, Rebecca W. Mahurin, Ph.D., declare as follows:

1. I reside at 5 West Cleveland St., Bozeman, Montana 59715.
2. I am Director of the Technology Transfer Office at Montana State University.
3. U.S. Patent Application No. 10/018,691 based on PCT/US99/15135, was originally assigned to Research and Development Institute, Inc. at reel 013436 frame 0108.
4. Montana State University maintains that it is assignee to the entire right and title to U.S. Patent Application No. 10/018,691 as the subject matter of this application was developed by employees of Montana State University using the facilities and equipment of Montana State University.
5. David M. Long is an original named inventor of U.S. Patent Application No. 10/018,691 based on PCT/US99/15135.
6. David M. Long was employed by Montana State University beginning in July 1998. David M. Long terminated his employment with Montana State University in December 1999. I believe the current address of David M. Long is 414 S. 8th Street, Livingston, MT 59047.

Attorney Docket No. 057309-5002-US  
Application No. 10/018,291  
Page 2

7. On October 16, 2002, responsibility for the prosecution of the above captioned patent application was transferred back to Montana State University from Research and Development Institute, Inc. at reel 013444, frame 0805.
8. On November 20, 2002, I telephoned David M. Long and requested that he sign a combined Declaration and Power of Attorney for the above captioned application. Dr. Long said that he would not sign the document. A copy of my notes from this conversation are attached as Exhibit A.
9. On January 8, 2003, I sent David M. Long, via certified mail, a full copy of the above captioned application, including claims, drawings, assignment, combined declaration and power of attorney and a letter requesting signature where required on each document. In this letter I indicated that given David Long's statements in our November 20, 2002, telephone conversation, if we did not receive the documents within two weeks of mailing this will constitute a refusal to sign. A copy of this letter is attached as Exhibit B.
10. On January 18, 2003 David Long received the aforementioned documents as evidenced by a Domestic Return Receipt that he signed. A copy of the Domestic Return Receipt is attached as Exhibit C.
11. As of today, David M. Long has not responded to our request to sign the aforementioned documents.
12. I further declare that all statements made herein of our own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-referenced patent.

Dated: 3/7/03

By: Rebecca W. Mahurin, Ph.D.  
Rebecca W. Mahurin, Ph.D.  
Director of Technology Transfer Office,  
Montana State University

Phone Call Notes  
Long, David  
11.20.02

41114-5002-US

10/018, 691

au

47714-5001-US

10/018, 551

I called David Long at home and left a message on his voice mail on the morning of November 20, 2002. (Home number 406-222-9416)

David returned my call less than an hour later and left on my voice mail his work number to call. (Work number 406-222-2986)

I called David back at the work number later in the morning of November 20, 2002. I asked if it was a problem to talk at work and he stated, "No."

I explained that RDI was now dissolved, and that all technology transfer matters were now being handled by my office. He asked why. I explained that it was an efficiency and cost saving move on the part of the University.

I then explained that I was working with the patent attorneys regarding the Telomerase patents. I asked if he would be willing to sign the assignments for the PTO, thus making it easier for us to obtain patents on these technologies. He responded that he would not be willing to sign. He said it was not in his best interests to sign. He said that we could proceed in any way we wanted to, and he would not try to interfere.

He explained that MSU had not been loyal to him and not done anything when he was not hired into a position in the Plant Sciences Department. He said that MSU could have given him lab space and a salary and he would have been happy to continue working at MSU, but that did not happen.

He said he did not harbor any grudges against me and knew that I had always been interested in him and his technology.

I explained that I would be sending him a letter for his signature. I would appreciate it if he would reconsider, but it was his option to either sign or not sign. He also stated that it would not be possible for MSU to patent without his signature. He asked if that was correct. I stated that it was my understanding that we may still be able to patent. He said he didn't see how we could exclude him as an inventor. I explained that he would be included as an inventor. I also stated that if we ever received any remuneration for this technology that we would share with him as though he had been cooperative. He said I should know that this issue was not about money. I told him I knew that, but that MSU would not deprive him of revenues. He said he appreciated that.

This was a friendly conversation. David and I have always had friendly conversations and this was no different.

LDM-1997-PESTAL



## OFFICE OF TECHNOLOGY TRANSFER

MSU • Bozeman  
P.O. Box 172460  
Bozeman, MT 59717-2460  
Telephone (406) 994-7868  
Fax (406) 994-4152  
E-mail: technologytransfer@montana.edu

47714-5001-US  
47714-5002-US

Advanced Technology Park  
900 Technology Blvd., Suite A  
Bozeman, MT 59718-6657  
Telephone (406) 994-7868  
Fax (406) 994-7001  
E-mail: technologytransfer@montana.edu

January 7, 2003

David Long, Ph.D.  
414 South 8<sup>th</sup>  
Livingston, MT 59047

Dear David:

Thank you for speaking with me on November 20, 2002 regarding the patent applications, "Taxol Production via Generation of Extrachromosomal DNAs in the Fungus Pestalotiopsis" and "In Vivo Addition of Telomeric Repeats to Exogenous DN Generates Extrachromosomal DNAs in the Fungus Pestalotiopsis."

In the November 20<sup>th</sup> conversation you stated that you would not sign the Assignments and Powers of Attorney for either of the above listed patent applications. I am sending to you the specifications for each of the two application listed above, including claims, drawings, Assignments and Combined Declaration and Powers of Attorney. I have marked each signature requirement with a blue sticky note labeled "sign." I ask that you please promptly sign and return the enclosed documents. Given that you have stated your refusal to sign documents for these two applications during our phone conversation of November 20, if we do not receive the documents from you within the next two weeks, this will constitute a refusal to sign.

I continue to desire to work with you in this matter, David. Please give this request your consideration. Should you have questions regarding this letter or matters related to these patent applications, please call me at 994-2752.

Thank you for your consideration of this request.

Sincerely,

A handwritten signature in cursive ink that reads "Rebecca W. Mahurin".

Rebecca W. Mahurin, Ph.D.  
Director, Technology Transfer Office

4-5001-US

4-5002-US

**SENDER: COMPLETE THIS SECTION**

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

David Long  
414 S. 8th St.  
Livingston, MT 59047-3303

**COMPLETE THIS SECTION ON DELIVERY**

A. Signature

X

Agent  
 Addressee

B. Received by (Printed Name)

David W. Long

C. Date of Delivery  
7/8/03

D. Is delivery address different from item 1?  Yes  
If YES, enter delivery address below:  No

3. Service Type

Certified Mail  Express Mail  
 Registered  Return Receipt for Merchandise  
 Insured Mail  C.O.D.

4. Restricted Delivery? (Extra Fee)  Yes

4. Postage Number

(Transferred from service label)

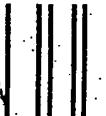
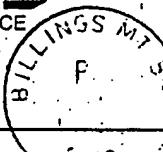
7002 0510 0003 4589 8422

PS Form 3811, August 2001

Domestic Return Receipt

102595-01-M-0381

UNITED STATES POSTAL SERVICE



First-Class Mail ~  
Postage & Fees Paid  
USPS  
Permit No. 6-40

• Sender: Please print your name, address, and ZIP+4 in this box •

Rebecca W. Mahurin  
Montana State University  
Technology Transfer Office  
900 Technology Blvd., Ste. A  
Bozeman, MT 59718-4011

